

REMARKS

Claims 1-22 are pending in the present application. Claims 1-22 have been rejected. Applicant has canceled claims 1-22. Applicant has added new claims 23-94. Consideration of pending claims 23-94 is respectfully requested.

The Examiner states:

This disclosure—including disclosed specification, drawings, and claims—is replete with grammatical, style, punctuation, and typographical errors too numerous to mention all specifically. Applicants must correct all errors in the application, whether or not specifically mentioned in this office action. The corrections, of course, may not introduce the matter.

Applicant has amended the specification accordingly.

Regarding drawings, the Examiner states:

The subject matter of this application, specifically claims 1-22 admit of illustration by drawings to facilitate understanding of the invention. Applicants are required to furnish drawings under 37 C.F.R. § 1.81. At the very least, Applicants must submit a drawing showing all of the steps of claims 1 and 12.

Pursuant to the Examiner's request, Applicant hereby submits new Figures 4A-4E and 5A-5E. Applicant has canceled claims 1 and 12 and replaced them with claims 23 and 59, respectively.

The Examiner objected to the Abstract of the Disclosure on the ground that it does not present that which is new in the art to which the invention of this application pertains. See M.P.E.P. § 608.01(b). The Examiner required correction.

Applicant has amended the Abstract accordingly.

The Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or to use the invention, i.e., failing to provide an enabling disclosure. The Examiner states:

The detailed description does not enable one of reasonable skill to make or practice, or both, the invention of claims 11 and 122. (sic)

Applicant has canceled claims 1-22. Applicant believes that new claims 23-94 are in compliance with 35 U.S.C. § 112.

The Examiner objected to the ordering of the claims as containing intervening claims between claims and the claims that depend therefrom. The Examiner states:

This is not in accordance with 37 C.F.R. § 1.75 (g), which states : "(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible. "The claims should be renumbered to conform with 37 C.F.R. § 1.75 (g). Correction is required.

Further, the Examiner rejected claims 11 and 22 under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Applicant has canceled claims 1-22. Applicant believes that new claims 23-94 are in compliance with 37 CFR § 1.75 (g) and 35 U.S.C. § 112.

The Examiner rejected claims 1-22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. The Examiner states:

In addition to the ambiguities specified below, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from the foreign document and are replete with grammatical and idiomatic errors.

- With respect to claims 1-22:

Although these claims are supposed to be defining a method invention, there does not seem to be any recited steps. On the other hand, the recitations do not seem to define structure either. This ambiguity renders indefinite scope of claims 1-11.

- With respect to claims 2 and 13:

It is unclear what "a digital signature is given to said digital data" means.

- With respect to claims 3 and 14:

It is unclear what "controlling copyright" means. Moreover, it is unclear what "copyright information for copyright" means.

- With respect to claim 18:

It is unclear what "encryption of said digital data is decrypted by said..." means.

Applicant has canceled claims 1-22. Applicant believes that new claims 23-94 are in compliance with 35 U.S.C. § 112.

The Examiner rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by reference to any of Dolphin, Fahn et al. [hereinafter Fahn], Okano, or Matsumoto et al. [hereinafter Matsumoto].

Applicant respectfully disagrees. Dolphin "relates to a system for delivering encrypted data on a portable data storage unit and transmitting an access code from a remote location to decrypt the encrypted data" as described

on lines 12-14 on column 1 of Dolphin. As such, Dolphin provides an access control scheme which uses an access code or key (interchangeable, column 2, line 64) to decrypt encrypted data (column 4, line 54). However, once access is obtained, no further protection is provided against possible unauthorized operations on documents. For example, copying, editing, transferring, or storing operations may be performed without any protection after decryption.

On the other hand, the present invention provides protections against performing unauthorized operations on documents that may violate copyrights associated with the operations. Independent claims 23 and 59 recite providing utilization permit keys that comprise at least one of a display permit key, an edit permit key, a storage permit key, a copy permit key, and a transfer permit key. There are no teachings or suggestions in Dolphin of providing a copyright control scheme with such utilization permit key.

Fahn "relates to the distribution of encrypted data objects over a broadcast channel, specifically to a cryptographic mechanism for resisting the unauthorized access to such data objects" as described on lines 8-11 on column 1.

In Fahn, once the document is accessed after decryption, control is released to whoever uses the document and no further protection is contemplated against unauthorized operations on the document. Unlike the present invention, therefore, Fahn does not teach providing utilization permit keys to control copyrighted operations such as copying and transferring.

Okano, like Dolphin, discloses an access control method and "relates to information processing systems using error - correcting codes and cryptography for processing and transmitting data including electronic documents, drawings, images, and data bases," as described on lines 10-13 on column 1.

On the other hand, the present invention provides protections against performing unauthorized operations on documents that may violate copyrights associated with the operations. For example, claims 23 and 59 recite utilization permit keys that cover various copyright related activities such as editing, storing, and transferring in addition to display. Since each of these operations may involve copyrights and violations thereof, the invention provides methods to protect copyrights with respect to the various document operations.

Unlike the present invention, in Okano, once the document is accessible after deciphering, no further consideration is provided to prevent possible unauthorized usage such as copying, or transferring. Okano does not teach or suggest providing a copyright control scheme with utilization permit keys comprising at least one of a display permit key, an edit permit key, a copy permit key, a storage permit key, and a transfer permit key as claimed in independent claims 23 and 59 of the present invention.

The invention of Matsumoto is directed to a technique that permits authorized use and authentication of documents using digital signatures as described on lines 18-21 on column 1. Matsumoto uses a secret key to encrypt "signature data" that includes hash total information, personal information

of signatory, and the subregion number. The signature data is decrypted by a public key and used to check the authenticity of received documents. However, document data is not included in encryption/decryption process.

Further, Matsumoto does not consider providing utilization permit keys to prevent unauthorized operations on documents that might violate copyrights. Matsumoto, instead, provides means for checking the authenticity and integrity of documents. As such, Matsumoto provides digital signatures that allows to check the authenticity and integrity of documents after such unauthorized operations have been performed. Unauthorized operations are not prevented and may be performed on documents. Matsumoto does not teach or suggest the invention as recited in claims 23 and 59.

None of these references discloses or suggests providing the copyright control in using digital data as claimed in the claims of the present invention.

The Examiner further rejected claims 2-11 under U.S.C. § 103 as being unpatentable over any of Dolphin, Fahn, Okano, or Matsumoto, as applied to claim 1 and 12, and further in view of what is well known. The Examiner states:

The deficiencies of the cited prior art, if any, with respect to the dependent claims 2-11 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

As discussed above with respect to Dolphin, Fahn, Okano, and Matsumoto references, Applicant believes that the invention is patentably

distinct over the prior art references. None of these references describes "a utilization permit key including a crypt key" in claim 23 (original claim 1) of the present application, and "a copyright control program", "copyright information" and "a copyright control message" in claim 25 (original claim 3) of the present application.

The Examiner rejected claims 12-22 under 35 U.S.C. § 103 as being unpatentable over Okano or Matsumoto further in view of Gasser et al. [hereinafter Gasser]. The Examiner states:

Gasser teaches transmitting a decryption key to authenticated entities authorized to access the data. To limit access to antedates the data base authenticates as authorized, it would have been obvious to incorporate the teachings of Gasser in the teachings of Okano or Matsumoto.

The deficiencies of the cited prior art, if any, with respect to the dependent claims 13-22 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

Gasser is directed to an access control technique for resources in distributed systems. Gasser uses a private-key and a public-key to authenticate a user and to delegate session keys from an entity to another for performing the access control to system resources.

On the other hand, the present invention, as recited in claim 59, provides a copyright control scheme with utilization permit keys that comprise at least one of a display permit key, an edit permit key, a copy permit key, a storage permit key and a transfer permit key. Thus, the copyright control scheme of the present invention provides protections against various unauthorized operations such as editing, transferring, and copying. Gasser

does not teach or suggest providing a copyright control scheme with utilization permit keys that include at least one of a display permit key, an edit permit key, a copy permit key, a storage permit key, and a transfer permit key.

Okano, Matsumoto and Gasser, either alone or in combination, do not describe "a utilization permit key including a crypt key," as recited in claim 59 (rewritten from claim 12) in the present invention, and "a copyright control program", "copyright information" and "a copyright control message," as recited in claim 61 (original claim 14) in the present invention.

Applicant believes that claims 59-94 (rewritten from claims 12-22) are patentably distinct over Okano, Matsumoto, and Gasser.

The Examiner rejected claims 1-22 on the ground that they are directed to an invention not patentably distinct from claims 1-26 of commonly assigned U.S. Patent Application S/N 08/549, 271. The Examiner states:

Specifically, claims 1-26 in said Application recite the same limitations as in this Application.

Commonly assigned U.S. Patent Application No., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a

rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

The Examiner adds:

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or a patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d). Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The Examiner has further rejected claims 1-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 08/549,271. The Examiner states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims of said U.S. Application recite the same limitations of the invention in this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner further states:

Claims 2-11 and 13-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 08/549,271 in view of what is well known.

The deficiencies of said U.S. Application, if any, with respect to the dependent claims 2-11 and 13-22 deal with features that are well known and commonly used in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant respectfully disagrees. The invention, as recited in independent claim 23 (rewritten from claim 1), is a method for "controlling copyrights of digital data" using "a utilization permit key", which comprises at least one of "a display permit key", "an edit permit key", "a storage permit key", "a copy permit key", and "a transfer permit key".

The invention described in claim 59 (rewritten from claim 12) of the present application is a method for controlling copyrights of digital data in which the digital data is encrypted again when the digital data is stored, copied or transferred using "a utilization permit key", which comprises at least one of "a display permit key", "an edit permit key", "a storage permit key", "a copy permit key", and "a transfer permit key".

On the contrary, the invention of US SN 08/549,271 described in independent claim 1 is "a data copyright management method used for producing new data by editing original data" using "first secret-key" of "a plurality of original data", "second secret-key of each said original data", "public-key of [said] primary user", "private-key of said primary user", and "digital signature on editing process data ... by using a private-key of said primary user".

As such, US SN 08/549,271 application does not teach or suggest providing "A display permit key", "an edit permit key", "a storage permit key", "a copy permit key" and "a transfer permit key". As discussed above, using a utilization key comprising an edit permit key, a copy permit key, or a storage permit key allows the invention to prevent unauthorized copy, edit,

or storage operations. Applicant believes that US SN 08/549,271 application does not teach or suggest a copyright control scheme using such a utilization key and the invention is patentably distinct from US SN 08/549,271.

Applicant, therefore, believes that double patenting is not present between US SN 08/549,271 patent application and the present application.

For the foregoing reasons, Applicant believes that none of the cited references, either alone or in combination, teach or suggest the present invention as claimed. Applicant believes that pending claims 23-94 are in condition for allowance and respectfully requests that they be allowed.

Respectfully submitted,

HECKER & HARRIMAN

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By:

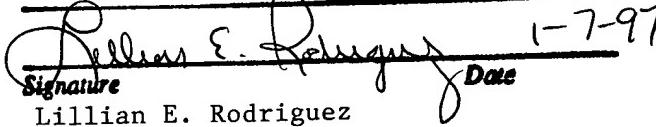
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